

REMARKS

Claims 1-42 were pending in the application. Claims 1, 2, 15, 18, 24, and 25 have been amended. Claims 3-11, 19-23 and 26-42 have been canceled. New claims 43-54 have been added. Accordingly, upon entry of this amendment, claims 1, 2, 12-18, 24-25, and 43-54 will be pending.

No new matter has been added. Specifically, support for the amendments to claim 1 can be found at least in claim 2 as filed and at page 17 lines 20-21. Support for the amendments to claims 2 and 49 can be found at least at page 15, line 23. Support for the amendments to claim 18 can be found at least at claim 2 as filed, page 17, lines 20-21, and pages 18-24. Support for new claim 43 can be found at least at pages 18-24. Support for new claims 44 and 50 can be found at least at page 12, lines 6-7. Support for new claims 45 and 53 can be found at least at page 21, lines 23-27. Support for new claims 46 and 54 can be found at least at page 23. Support for new claims 47 and 51 can be found at least at page 18, line 5. Support for new claims 48 and 52 can be found at least at page 20, lines 1-2.

Any amendments to and/or cancellation of the claims were made solely to more particularly point out and distinctly claim the subject matter of Applicants' invention in order to expedite the prosecution of the application. Applicants reserve the right to pursue the claims as originally filed in this or a separate application(s).

RESPONSE TO RESTRICTION REQUIREMENT

The Examiner has required restriction to one of the following inventions under 35 U.S.C. § 121:

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| Group I: | Claims 2, 5-18 and 33-35 are drawn to a method for delivering a ligand or ligands, to a cell, wherein the ligand is an oligonucleotide, classifiable in class 435, subclass 455. |
| Group II: | Claims 3, 8-18 and 33-35 are drawn to a method for delivering a ligand or ligands, to a cell, wherein the ligand is a peptide, classifiable in class 424, subclass 143.1. |
| Group III: | Claims 4, 8-18 and 33-35 are drawn to a method for delivering a ligand or ligands, to a cell, wherein the ligand is a fluorescent virus, classifiable in class 424, subclass 93.1. |
| Group IV: | Claims 20 and 23-32 are drawn to a method for releasing ligands from endosomes in cells at a localized site in a subject, wherein the ligands are fluorescent oligonucleotides, classifiable in class 435, subclass 455. |
| Group V: | Claims 21 and 26-32 are drawn to a method for releasing ligands from endosomes in cells at a localized site in a subject, wherein the ligands are fluorescent peptides, classifiable in class 424, subclass 143.1. |
| Group VI: | Claims 22 and 26-32 are drawn to a method for releasing ligands from endosomes in cells at a localized site in a subject, wherein the ligands are fluorescent viruses, classifiable in class 424, subclass 93.1. |

- Group VII: Claim 37 is drawn to a method of enhancing protein production at a localized site in a subject, classifiable in class 424, subclass 143.1.
- Group VIII: Claim 38 is drawn to a method of inhibiting protein production at a localized site in a subject, classifiable in class 435, subclass 375.
- Group IX: Claim 40 is drawn to a method of enhancing protein activity at a localized site in a subject, classifiable in class 424, subclass 143.1.
- Group X: Claim 41 is drawn to a method of inhibiting protein activity at a localized site in a subject, classifiable in class 424, subclass 143.1.
- Group XI: Claim 42 is drawn to a method of treating a disorder comprising enhancing the availability of a ligand that provides a treatment for a disorder, classifiable in class 435, subclass 968.

It is the position of the Examiner that Groups I-XI are unrelated because they are “not disclosed as capable of use together and have different modes of operation, different functions, or different effects (MPEP §806.04, MPEP §808.01).”

Applicants provisionally elect **Group I, with traverse**, for prosecution on the merits. Applicants’ grounds for traversal are set forth below.

The pending claims have been amended such that they all pertain to methods of releasing an oligonucleotide from an endosome in a cell. Applicants traverse the restriction requirement to the extent that Group I should be reformed as a single group containing presently pending claims 1, 2, 12-18, 24-25, and 43-54 (referred to hereinafter as “**newly formed Group I**”).

It is respectfully submitted that Applicants have presented an allowable generic claim, claim 1, which is generic to the pending claims. Claim 1, as amended, is drawn to a method of releasing a an oligonucleotide from an endosome in a cell comprising contacting the cell with the oligonucleotide and a fluorophore such that the oligonucleotide and the fluorophore are present

in an endosomal vesicle in the cell and illuminating the cell with light at a wavelength that activates the fluorophore such that the oligonucleotide is released from the endosome.

Claim 1 embraces the species of ligands recited in the presently pending claims. The claimed ligands also are connected in operation and effect. Moreover, Applicants submit that examination of the claims in the present application would not place an undue burden on the Examiner, since the prior art searches for these claims would be co-extensive and, as such, would not require undue burden on the Examiner. As stated in the M.P.E.P § 803:

[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Applicants hereby elect *newly formed Group I*, presently pending claims 1, 2, 12-18, 24-25, and 43-54.

Applicants believe no additional fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 12-0080, under Order No. IVG-001 from which the undersigned is authorized to draw. A duplicate of this sheet is enclosed.

Dated: December 3, 2004

Respectfully submitted,

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